

Freedom of Information Act ("FOIA") Requests in the USPTO

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The records of the USPTO store a wealth of useful information. Much of that information is available from the USPTO's web site. The most basic information is the disclosure of inventions in US patent applications. However, the USPTO also stores records of proceedings, such as description of and actual papers in applications, appeals, and other proceedings, internal policies in manuals, and contracts with its vendors. However, much of the USPTO's information is not available, or not available in useful form. For example, the USPTO web site's PAIR database provides records of documents in publicly available patent applications, including both a description of the paper and an image of the paper.² However, there is no mechanism to search on the descriptions of papers in the PAIR database. Similarly, most of the USPTO's ongoing interference proceedings are not searchable, despite the existence of a test interference search engine.³⁴

There is a mechanism for members of the public to request information from the USPTO via a FOIA request. This paper summarizes how the USPTO implements FOIA, how to request information from the USPTO, and what to do if notified that your corporate information has been requested under FOIA

The USPTO web site provides general guidance on FOIA requests at <http://www.uspto.gov/web/offices/com/sol/foia/>. It states that:

The Freedom of Information Act (FOIA) is a federal statute which affords any person the right to obtain federal agency records, unless the records (or a part of the records) are protected from disclosure by any of the nine 1. exemptions contained in the law. On October 2, 1996, President Clinton signed into law the Electronic Freedom of Information Act Amendments of 1996 (E-FOIA, for short). E-FOIA will make it possible for you to have electronic access to the USPTO FOIA Reading Room, offering such information as Final Agency Decisions and our most frequently requested FOIA documents.

The USPTO promulgated regulations implementing FOIA. See "Public Information, Freedom of Information and Privacy." at 65 FR 52916. These rules are in the Code of Federal Regulations ("CFR") at sub section 37 CFR 102. Rule 102.3 specifies the scope of USPTO FOIA available information.

102.3 Records under FOIA.

(a) Records under FOIA include all Government records, regardless of format, medium or physical characteristics, and include electronic records and information, audiotapes, videotapes, and photographs.

Rule 102.4 specifies the requirements for requesting such information.

102.4 Requirements for making requests.

(a) A request for USPTO records that are not customarily made available to the public as part of USPTO's regular informational services must be in writing, and shall be processed under FOIA, regardless of whether FOIA is mentioned in the request. Requests should be sent to the USPTO FOIA Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450 (records FOIA requires to be made regularly available for public inspection and copying are addressed in § 102.2(c)). For the quickest handling, the request letter and envelope should be marked "Freedom of Information Act Request." For requests for records about oneself, § 102.24 contains additional requirements.

For requests for records about another individual, either a written authorization signed by that individual permitting disclosure of those records to the requester or proof that individual is deceased (for example, a copy of a death certificate or an obituary) facilitates processing the request.

(b) The records requested must be described in enough detail to enable USPTO personnel to locate them with a reasonable amount of effort. Whenever possible, a request should include specific information about each record sought, such as the date, title or name, author, recipient, and subject matter of the record, and the name and location of the office where the record is located. Also, if records about a court case are sought, the title of the case, the court in which the case was filed, and the nature of the case should be included. If known, any file designations or descriptions for the requested records should be included. In general, the more specifically the request describes the records sought, the greater the likelihood that USPTO will locate those records. If the FOIA Officer determines that a request does not reasonably describe records, the FOIA Officer will inform the requester what additional information is needed or why the request is otherwise insufficient. The FOIA Officer also may give the requester an opportunity to discuss the request so that it may be modified to meet the requirements of this section. [Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

Rules 102.5-102.7 specify how the USPTO responds to FOIA requests. They read in most pertinent parts:

§ 102.5 Responsibility for responding to requests.

(a) In general. Except as stated in paragraph (b) of this section, the USPTO will process FOIA requests directed to USPTO. In determining records responsive to a request, the FOIA Officer shall include only those records within USPTO's possession and control as of the date the FOIA Officer receives the request. ***

102.6 Time limits and expedited processing.

(a) In general. The FOIA Officer ordinarily shall respond to requests

according to their order of receipt.

(b) Initial response and appeal. Subject to paragraph (c)(1) of this section, an initial response shall be made within 20 working days (i.e., excluding Saturdays, Sundays, and legal public holidays) of the receipt of a request for a record under this part by the proper FOIA Officer identified in accordance with § 102.5(a), and an appeal shall be decided within 20 working days of its receipt by the Office of the General Counsel. ***

102.7 Responses to requests.

(a) Grants of requests. If the FOIA Officer makes a determination to grant a request in whole or in part, the FOIA Officer will notify the requester in writing. The FOIA Officer will inform the requester in the notice of any fee charged under § 102.11 and disclose records to the requester promptly upon payment of any applicable fee

(b) Adverse determinations of requests. If the FOIA Officer makes an adverse determination regarding a request, the FOIA Officer will notify the requester of that determination in writing. An adverse determination is a denial of a request in any respect,....

The USPTO's FOIA rules contain a mechanism for private parties to object to a FOIA disclosure if it would release their confidential business information. This is the information of the type identified in FOIA as trade secrets and commercial or financial information obtained from a person that is privileged or confidential. The most pertinent part of these rules follow:

102.9 Business Information.

(a) In general. Business information obtained by USPTO from a submitter will be disclosed under FOIA only under this section.

(b) Definitions. For the purposes of this section:

(1) Business information means commercial or financial information, obtained by USPTO from a submitter, which may be protected from disclosure under FOIA exemption 4 (5 U.S.C. 552(b)(4)).

(c) Designation of business information. A submitter of business information should designate by appropriate markings, either at the time of submission or at a reasonable time thereafter, any portions of its submission that it considers to be protected from disclosure under FOIA exemption 4. These designations will expire ten years after the date of the submission unless the submitter requests, and provides justification for, a longer designation period.

(d) Notice to submitters. The FOIA Officer shall provide a submitter with prompt written notice of a FOIA request or administrative appeal that seeks its business information whenever required under paragraph (e) of this section, except as provided in paragraph (h) of this section, in order to give the submitter

an opportunity under paragraph (f) of this section to object to disclosure of any specified portion of that information. Such written notice shall be sent via certified mail, return receipt requested, or similar means. The notice shall either describe the business information requested or include copies of the requested records containing the information. When notification of a large number of submitters is required, notification may be made by posting or publishing the notice in a place reasonably likely to accomplish notification.

(e) When notice is required. Notice shall be given to the submitter whenever:

(1) The information has been designated in good faith by the submitter as protected from disclosure under FOIA exemption 4; or

(2) The FOIA Officer has reason to believe that the information may be protected from disclosure under FOIA exemption 4.

(f) Opportunity to object to disclosure. The FOIA Officer shall allow a submitter seven working days (i.e., excluding Saturdays, Sundays, and legal public holidays) from the date of receipt of the written notice described in paragraph (d) of this section to provide the FOIA Officer with a detailed statement of any objection to disclosure. The statement must specify all grounds for withholding any portion of the information under any exemption of FOIA and, in the case of exemption 4, it must show why the information is a trade secret or commercial or financial information that is privileged or confidential. If a submitter fails to respond to the notice within the time specified, the submitter will be considered to have no objection to disclosure of the information. Information a submitter provides under this paragraph may itself be subject to disclosure under FOIA.

The most important point to note from this section is the 7 day time limit. Any entity receiving a 102.9(d) notice needs to respond *immediately*, instead of letting such a notice go through normal course of business processing.

Rule 102.10 specifies the procedure for appeal of an adverse determination of, and untimely response to, a FOIA request.

Rule 102.11 specifies fees associated with FOIA requests. It generally specifies the requester paying the USPTO for the costs of time and effort in complying with the request. However, it notes exceptions for certain types of entities (reporters, universities and the like), and when the grant of the request generally benefits the public, not the pecuniary interests of the requester. As to the public interest fees exception, rule 102.11(k) states that:

102.11 Fees ... 102.11(k) Requirements for waiver or reduction of fees.

(1) Records responsive to a request will be furnished without charge or at a charge reduced below that established under paragraph (c) of this section if the FOIA Officer determines, based on all available information, that the requester has demonstrated that: (i) Disclosure of the requested information is in the public interest because it is likely to contribute significantly to public understanding of

the operations or activities of the Government; and (ii) Disclosure of the information is not primarily in the commercial interest of the requester.

(2) To determine whether the first fee waiver requirement is met, the FOIA Officer shall consider the following factors: (i) The subject of the request: whether the subject of the requested records concerns the operations or activities of the Government. The subject of the requested records must concern identifiable operations or activities of the Federal Government, with a connection that is direct and clear, not remote or attenuated.

(ii) The informative value of the information to be disclosed: whether the disclosure is “likely to contribute” to an understanding of Government operations or activities. The disclosable portions of the requested records must be meaningfully informative about Government operations or activities in order to be “likely to contribute” to an increased public understanding of those operations or activities. The disclosure of information that already is in the public domain, in either a duplicative or a substantially identical form, would not be likely to contribute to such understanding.

(iii) The contribution to an understanding of the subject by the public likely to result from disclosure: whether disclosure of the requested information will contribute to the understanding of a reasonably broad audience of persons interested in the subject, as opposed to the individual understanding of the requester. A requester’s expertise in the subject area and ability and intention to effectively convey information to the public shall be considered. It shall be presumed that a representative of the news media satisfies this consideration. It shall be presumed that a requester who merely provides information to media sources does not satisfy this consideration.

(iv) The significance of the contribution to public understanding: whether the disclosure is likely to contribute “significantly” to public understanding of Government operations or activities. The public’s understanding of the subject in question prior to the disclosure must be significantly enhanced by the disclosure.

(3) To determine whether the second fee waiver requirement is met, the FOIA Officer shall consider the following factors:

(i) The existence and magnitude of a commercial interest: whether the requester has a commercial interest that would be furthered by the requested disclosure. The FOIA Officer shall consider any commercial interest of the requester (with reference to the definition of “commercial use request” in paragraph (b)(1) of this section), or of any person on whose behalf the requester may be acting, that would be furthered by the requested disclosure. Requesters shall be given an opportunity to provide explanatory information regarding this consideration.

(ii) The primary interest in disclosure: whether any identified commercial interest of the requester is sufficiently large, in comparison with the public interest in disclosure, that disclosure is “primarily in the commercial interest of the requester.” A fee waiver or reduction is justified if the public interest standard

(paragraph (k)(1)(i) of this section) is satisfied and the public interest is greater than any identified commercial interest in disclosure. The FOIA Officer ordinarily shall presume that if a news media requester has satisfied the public interest standard, the public interest is the primary interest served by disclosure to that requester. Disclosure to data brokers or others who merely compile and market Government information for direct economic return shall not be presumed to primarily serve the public interest.

(4) If only some of the records to be released satisfy the requirements for a fee waiver, a waiver shall be granted for those records.

(5) Requests for the waiver or reduction of fees should address the factors listed in paragraphs (k)(2) and (3) of this section, insofar as they apply to each request. [Added, 65 FR 52916, Aug. 31, 2000, effective Oct. 2, 2000]

Thus, determination of whether to charge the FOIA requester fees resulting from a FOIA request balance a number of factors including the commercial value to the requester, ability of the USPTO to respond to the request, whether the information is already available in a useful form, and benefit to the public.

In summary, FOIA requests can be useful for obtaining information from the USPTO.

1. I can be reached via telephone at 703-415-0012 or via the firm's web site: www.Neifeld.com.
2. In fact, the specification for those codes is publicly available at:
<http://www.uspto.gov/ebc/portal/ifw-tab-doccodes.html>.
3. That search engine is available at <https://acts.uspto.gov/ifiling/PublicView.jsp>. However, searches on that database returns only a few tens of interference proceedings.
4. In contrast to the BPAI interference search engine, it appears that all of the TTAB's opposition proceedings are available for search using its search engine.